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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,721	08/05/2003	Thomas M. Baer	ARC012000107	1943
7590 05/04/2005			EXAMINER	
Rimas Lukas Lukas IP Group PO Box 3295 Half Moon Bay, CA 94019-3295			NGUYEN, TU T	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,721	<b>Applicant(s)</b> BAER ET AL.	
	<b>Examiner</b> Tu Nguyen	<b>Art Unit</b> 2877	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27 and 30 is/are allowed.
- 6) ☒ Claim(s) 28-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonner et al (6,251,516) in view of Takahashi (5,656,812).

With respect to claim 28, Bonner discloses a Laser Micro Dissection (LCM hereinafter). The LCM comprises: a microscope 3 (fig 1) (column 4, lines 15-48, lines 50-51); a laser 36 (fig 8C) having a beam path 36 (fig 8C), a translation stage 2, 30 (fig 1, 8a) for receiving the sample (column 4, lines 44-48). Bonner does not explicitly disclose using a joystick for moving the translation stage. However, Takahashi discloses a microscope for inspecting a specimen. The microscope comprises a joystick to move the translation stage (column 4, lines 4-23). It would have been obvious to implement the joystick taught by Takahashi to the translation stage of Bonnet in order to make it easier for the user to control the movement of the translation stage.

With respect to claim 29, since Takahashi teaches that the joystick permits the operator to move the translation stage (column 4, lines 12-15), Takahashi obviously encompasses teaching that joystick is manual.

***Allowable Subject Matter***

Claims 22-27,30 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior arts of record do not disclose a LCM system. The system comprises: a joystick connected to a translation stage, the joystick being configured to reduce a scalar movement defined by an operator and having a leverage ratio to control sample movement as a function of operator hand movement which structurally arranged and functionally operated as claimed in claim 22.

***Response to Arguments***

Applicant's arguments filed 02/08/2005 have been fully considered but they are not persuasive.

In response to applicant's argument on page 5 through page 6, Bonner does not disclose the joystick as admitted by examiner in the section 35 USC 103 above. The joystick used for moving the translation stage of a microscope is disclosed by Takahashi in col.4, lines 4-19. It is noted that the filing date of Takahashi patent is on July 19, 1996 that is well before the earliest US effective filing date of the present application (the earliest US filing date of the present application should be on 10/1/1997 for the provisional application 60/060,731 which discloses the joystick). Bonner teaches other features such as the microscope, the laser, the translation stage in the parent applications, namely, in the provisional application 60/036,927 (filing date

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2/7/1997) and in the parent application patent No. 5,843,657 ('657 hereinafter) (filing date 10/10/1995) the relevant sections taught in patent '657 are col.4, lines 25-39; col.5, lines 1-11; col.12, lines 8-17, lines 51-54; col.13, lines 1-30. In the patent '657, the movement of sample can be made by the transfer surface 30 (fig.8A) (col.13, lines 1-4), patent '657 also implies the movement of the translation stage 2 (fig.1) in col.5, lines 2-4 because if the stage of the microscope is fixed, the position of the stage is not necessarily detected each time the computer performs the control. Moreover, it is noted that claim 28 does not disclose the movement of the sample as asserted by the applicant.

The same ground of rejection is herein maintained, accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Toatley Gregory can be reached on (571) 272-2059. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu Nguyen  
Primary Examiner  
Art Unit 2877

04/28/2005